

Remarks/Arguments

35 U.S.C. §102 Claim Rejections

Examiner has rejected claims 17 and 23 under 35 U.S.C. §102 (b) as being anticipated by Simon et al., U.S. 4,918,523. Although Applicants disagree with Examiner's rejection, Applicants have cancelled claims 17 and 23 in order to advance the prosecution. Therefore, this rejection is now moot and should be withdrawn.

35 U.S.C. §103(a) Claim Rejections

Examiner has rejected claims 18 and 24 under 35 U.S.C. §103 (a) as being anticipated by Simon et al., U.S. 4,918,523, in view of Ferre et al, U.S. 4,707,738. In response, Applicants have cancelled claim 18 and amended claim 24. As amended, claim 24 is believed to be patentable over the cited references.

As Examiner has already noted in the office action, Simon fails to teach the limitation of "...using weighting coefficients, high spatial frequencies being less weighted than low spatial frequencies..." as recited in claim 24.

In addition, neither Simon nor Ferre discloses or suggests the added limitation of "...wherein a first coefficient of the intra coded blocks is not modified by the weighting coefficients", as now recited in amended claim 24. Support for this limitation is found at least on page 16, lines 25 to 30 of the present specification.

In view of the above, it is respectfully requested that amended claim 24 be allowed.

Withdrawal of Requirement to File Terminal Disclaimer and Rendering it Null

In his office action, Examiner has advised that Applicants need to provide a copy of Terminal Disclaimer filed Sept. 13, 1993, along with a cover letter requesting the Terminal Disclaimer be recorded on the continuation application, in order to comply with the requirement of the petition decision rendered on September 29, 1995.

In reviewing our file, Applicants believe we have already submitted these documents as part of the divisional patent application filed on Feb. 8, 2002, via Express Mail No. EL 912752262 US. Applicants are attaching a copy of the documents submitted, as well as the Utility Patent Application Transmittal, the Express Mail filing receipt and the returned post card receipt as Attachment 1. This Terminal Disclaimer, however, apparently has not been recorded and made public in connection with this divisional application, in view of Examiner's request that it be refilled.

Applicants hereby request that Examiner withdraw the requirement to file the Terminal Disclaimer and declare the effect of the Terminal Disclaimer filed be considered null in connection with this divisional application, Ser. No. 10/071,352.

MPEP 1490 specifically provides that "...**there is no statutory prohibition against nullifying or otherwise canceling the effect of a recorded terminal disclaimer** which was erroneously filed before the patent issues...**The filing of a continuing application other than a CPA, while abandoning the application in which the terminal disclaimer has been filed, will typically nullify the effect of a terminal disclaimer.**" (Underline and Italic added for emphasis).

The terminal disclaimer at issue in this case was filed as part of a petition to revive an abandoned application having a filing date prior to June 8, 1995. The terminal disclaimer was filed under the version of 37 C.F.R. § 1.137 then in effect, which set forth the conditions for the revival of abandoned applications. The terminal disclaimer was filed on September 13, 1993, when the statutory term of a patent was seventeen years from its grant date. At that time, Section 1.137 provided that:

(c) Any petition pursuant to paragraph (a) of this section not filed within six months of the date of abandonment ***must be accompanied by a terminal disclaimer*** with fee under § 1.321 ***dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment*** of the application. 37 C.F.R. 1.137(c), revised July 1, 1983.

On June 8, 1995, the Uruguay Round Agreements Act (URAA) took effect, changing the patent term for applications filed on or after that date to twenty years *from the effective date of filing* of the patent application.¹ Section 1.137 was thus amended to read:

(c) ***In all applications filed before June 8, 1995***, and in all design applications filed on or after June 8, 1995, any petition pursuant to paragraph (a) of this section not filed within six months of the date of abandonment of the application, ***must be accompanied by a terminal disclaimer*** with fee under § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application...

The Office explained that this amendment was needed in order to implement the twenty-year patent term provisions of the URAA.² Indeed, the amended rule eliminated the requirement of a terminal disclaimer for *all utility applications filed after June 8, 1995* because, for these applications, any delay in the issuance of the patent, which is caused by the period of abandonment, automatically results in the loss of patent term. A terminal disclaimer filed in these applications would thus amount to a *double penalty* against Applicants. Specifically, the Office stated:

Section 1.137 is being amended by revising paragraph (c) to ***eliminate, in all applications filed on or after June 8, 1995,*** except design applications, ***the requirement that a terminal disclaimer accompany any petition under § 1.137(a) not filed within six (6) months of the date of the abandonment of the application.***

The language "filed before June 8, 1995" and "filed on or after June 8, 1995" as used in the amended rule, refer to the actual United States filing date, without reference to any claim for benefit under 35 U.S.C. 120, 121, or 365. No change to § 1.137 was proposed in the

¹ See 35 U.S.C. § 154(a)(2) (2000).

² 60 FR 20195, April 25, 1995.

Notice of Proposed Rulemaking. However, *in all applications filed on or after June 8, 1995*, except design applications, *any delay in filing a petition under § 1.137(a) will automatically result in the loss of patent term*. The loss of patent term will be the incentive for applicants to promptly file any petition to revive. *Therefore, no need is seen for requiring a terminal disclaimer in such applications. It would amount to a penalty if a terminal disclaimer was required.*¹

The present version of Section 1.137 provides the same exemption from filing a terminal disclaimer in applications filed after June 8, 1995, but in even more explicit terms:

(d) Terminal disclaimer.

(1) ...Any petition to revive pursuant to this section in either a utility or plant application filed **before June 8, 1995**, must be accompanied by a terminal disclaimer and fee as set forth in § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon ...

(2) Any terminal disclaimer pursuant to paragraph (d)(1) of this section must also apply to any patent granted on a continuing utility or plant application **filed before June 8, 1995**, or a continuing design application, that contains a specific reference under 35 U.S.C. 120, 121, or 365(c) to the application for which revival is sought.

¹ *Id.* at 20199.

(3) The provisions of paragraph (d)(1) of this section do not apply to applications for which revival is sought solely for purposes of copendency with a utility or plant application filed on or after June 8, 1995, to lapsed patents, to reissue applications, or to reexamination proceedings.

Therefore, the Office's position is that a terminal disclaimer does not apply to patents granted on continuing utility applications filed after June 8, 1995. Further, a terminal disclaimer is not required to revive an application filed after June 8, 1995. Hence, consistent with the above-discussed Office's position regarding Section 1.137, the terminal disclaimer filed in the '515 application should not apply to patents granted on continuing utility applications filed after June 8, 1995, such as this divisional application filed February 8, 2002. Consequently, there should not be a requirement to carry over such a Terminal Disclaimer and its effect should be rendered null in connection with the present application. Hence, Examiner is respectfully requested to withdraw the requirement to file the Terminal Disclaimer in the instant application.

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PATENT
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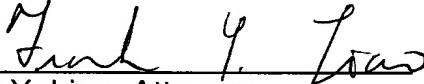
Conclusion

Having fully addressed the Examiner's rejections it is believed that, in view of the preceding amendments and remarks, this application stands in condition for allowance. Accordingly then, reconsideration and allowance are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the Applicants' attorney at (609) 734-6821, so that a mutually convenient date and time for a telephonic interview may be scheduled.

Respectfully submitted,
ERIC AUVRAY ET AL.

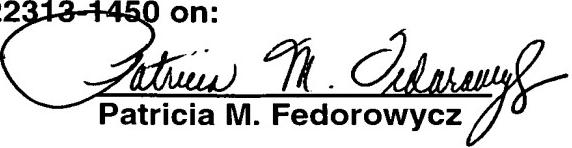
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Attachments

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CERTIFICATE OF MAILING under 37 C.F.R. §1.8
I hereby certify that this amendment is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

Date: March 10, 2005


Patricia M. Fedorowycz